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Ronald E. Sloan

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EXAMINER

APPLE, KIRSTEN SACHWITZ

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3694

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/704,838	Applicant(s) SLOAN ET AL.	
	Examiner KIRSTEN S. APPLE	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

This action is in response to the applicants RCE filed on 3/17/09.

Examiner Comments

A new non-final office action is being submitted because the examiner became aware that a typo was contained in the office action mailed 4/22/09. The typo was that Sullivan reference was typed when the examiner was looking at and intended to write "Albright". The correction has been made in the below office action.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission has been entered.

Claim Rejections - 35 USC § 103

The Examiner has read and reviewed all of the information provided by the Applicant. The examiner rejects as final claims 1-25 under 35 USC 103.

The Applicant's attention is re-drawn to the following:

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being obvious over Wolfberg et al. (US Patent No. 5,214,579), in further view of Sullivan et al. (US Patent No. 6,615, 240), in further view of Albright (US Patent 6,012,043) in further view of Farry et al. (US Patent No. 6,069,628) in further view of Official Notice.

Claims 1, 9, 10, and 18:

Wolfberg discloses a method, a system, and a computer program embodied on a computer readable medium for providing a graphical user interface to a financial modeling system allowing advice through projections (Col. 3, line 63-col. 4, line 10, col. 10, lines 40-55, col. 11, lines 27-29, col. 12, lines 38-49, col. 16, lines 4-41, col. 19, lines 24-35, col. 29, lines 18-38, col. 30, lines 3-44) and trends (Col. 23, lines 37-54) of a financial system (Col. 4, line 9-col. 5, line 11) based on a network architecture (Col. 7, line 53-col. 8, line 9), which determine the expectations (Col. 17, line 65-col. 18, line 20) and impact (Col. 1, line 55-col. 2, line 12, col. 2, line 42) of investment decisions. Including life intentions being received as revenue and expense goals (Col. 3, line 63-col. 4, line 10, col. 10, lines 40-55, col. 11, lines 27-29, col. 12, lines 38-49, col. 16, lines 4-41, col. 19, lines 24-35, col. 29, lines 18-38, col. 30, lines 3-44) and modification to life intentions (Col. 1 line 55-69 "supplemented" + col. 9 line 26-37 + Figure 7) Wolfberg does not exclude that his invention could be used to give advice, as a help-system for the investors, or manage risk, but he does not explicitly disclose this possibility of use.

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Sullivan discloses an Internet-based system (Col. 1, line 18-col. 2, line 4, col. 4, lines 5762, col. 5, lines 5-38, col. 13, lines 36-51, col. 14, lines 22-23) that support both live advice & providing communication interface (or live help, Abstract, col. 3, lines 36-62, col. 4, line 63-col. 5, line 4, col. 6, lines 20-63, col. 7, lines 12-28, col. 8, lines 9-22, col. 10, line 22-col. 12, line 12, col. 13, line 56-col. 14, line 63, col. 15, line 1-col. 16, line 67, col. 17, line 8-col. 18, line 10) and automated coaching & live coaching (Abstract, col. 6, lines 39-50, col. 12, lines 39-50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the Wolfberg invention was made to use it for a live advice and automated coaching. One would have been motivated to use for live advice and automated coaching the Wolfberg invention in order to maximize its applications, and consequently, the revenues that result from its use.

The Wolfberg-Sullivan invention does not explicitly disclose risk factor.

Albright teaches managing risk including:

providing a risk modeling component for allowing the user to control the level of risk (see Albright, column 8, lines 55-58),
by allowing the user to select one or more risk events from a list of risk events (see Albright, column 8, lines 55-58),
based on actuarial data from at least one external database, providing estimates of a probability and effect of an occurrence of the selected one or more risk events, and

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for each individual risk event from the selected one or more risk events, allowing the user to accept the estimate associated with the risk even, or to reject the estimates and substitute in a different estimate (see Albright, column 8, lines 55-58 + claim 42)

The Wolfberg-Sullivan-Albright invention does not explicitly disclose providing a first window for displaying an image of said live advisor; and providing a second window for displaying context sensitive automated coaching. Ferry discloses a system which provides financial system services (Col. 4, lines 23-64) using a first window (Col. 2, lines 23-55, col. 14, lines 50-67, col. 16, lines 21-39) and a second window (Col. 2, lines 28-49, col. 14, lines 50-67, col. 16, lines 21-39). Therefore, it would have been obvious to one having ordinary skill in the art at the time the Wolfberg-Sullivan-Albright invention was made to use this step. One would have been motivated to use this step in the Wolfberg-Sullivan-Albright invention in order to facilitate the search of advice for the user.

The Wolfberg-Sullivan-Albright-Ferry invention does not explicitly disclose providing a plurality of icons for selecting at least one of a plurality of methods for communicating with a live advisor over the Internet.

Automated coaching driven by a financial coaching system that comprises one or more coaching engines; wherein the automated coaching incorporates the selected risk events. The examiner takes Official notice that using life coaching as a means of communication in the computer art. Clearly Wolfberg contains communication on the elements for life coaching.

Claims 2, 11, and 19: Wolfberg, Sullivan, Albright and Ferry disclose the method, the system, and the computer program embodied on a computer readable medium of

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claims 1, 9, and 18. Wolfberg discloses a network architecture (see Claim 1 above) which could be also the Internet network. Sullivan explicitly discloses Internet (see Claim 1 above), and it is well known that the Internet network is a plurality of methods for communication that includes email, electronic chat, live streaming audio, voice over the network, telephone, still picture, and streaming live video. Therefore, it would have been obvious to one having ordinary skill in the art at the time the Wolfberg invention to use this step. One would have been motivated to use this step in the in order to increase the possibilities of communication for the user.

Claims 3, 12 and 20: Wolfberg, Sullivan, Albright and Ferry disclose the method, the system, and the computer program embodied on a computer readable medium of claims 1, 9, and 18. Wolfberg also discloses an user interface that includes providing one interactive window for displaying a financial model generated by the financial modeling system (Fig 9C).

Claims 4, 13, and 21: Wolfberg, Sullivan, Albright and Ferry disclose the method, the system, and the computer program embodied on a computer readable medium of claims 3, 12, and 20. Wolfberg, Sullivan, and Ferry do not explicitly disclose that the user interface includes a plurality of function icons for performing various operations on said generated financial model. The examiner takes Official notice that this feature is old and well-known in the computer art because it is very easy for a user to pick an icon instead of giving a command to a financial program by different way.

Claims 5, 14, and 22: Wolfberg, Sullivan, Albright and Ferry disclose the method, the system, and the computer program embodied on a computer readable medium of claims 4, 13, and 21. Wolfberg, Sullivan, and Ferry do not explicitly disclose that the function icons include providing at least one of transact, monitor, model, explore, track. The examiner takes Official

notice that this feature is old and well-known in the computer art because it is very easy for a user to pick an icon instead of giving a command to a financial program by different way.

Claims 6, 15, and 23: Wolfberg, Sullivan, and Ferry disclose the method, the system, and the computer program embodied on a computer readable medium of claims 3, 12, and 20.

Wolfberg also discloses that the user interface includes at least one dynamic window for displaying characteristics related to the generated financial model (Fig. 9C, 10A, 10B, and 10

C). **Claims 7, 16, and 24:** Wolfberg, Sullivan, Albright and Ferry disclose the method, the system, and the computer program embodied on a computer readable medium of claims 1, 9, and 18. Sullivan discloses a Financial system service Internet-based the wherein said user interface that includes providing at least one interactive window for displaying help messages related to using the financial modeling system, as is used in many automated coaching systems (see discussion on Claim 1 above).

Claims 8, 17, and 25: Wolfberg, Sullivan, Albright and Ferry disclose the method, the system, and the computer program embodied on a computer readable medium of claims 1, 9, and 18. Wolfberg, Sullivan, and Ferry does not explicitly disclose wherein said user interface further includes providing at least one profile icon for performing various operations on a user profile based on user information. The examiner takes Official notice that this feature is old and well known in the computer art because it is very easy for a user to pick an icon instead of giving a command to a financial program by different way.

Examiner Comments

In addition the examiner would like to note that while she choose Walker as a solid prior art reference the examiner believe this application reads on lots of prior art and more important to that what happens in practice in practically every financial service company that offers any

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kind of “private client services”. For example, American Express or Merrill Lynch offers a similar service of taking data (“life goals”) of their customers and providing reports to help them understand their financial position. If thing change the client call or communicates (such as the “life coach”) the change. It is important to note that simply automating an existing method that have been happening in the field for years does not make it novel. In other words, taking the patent filling or ticketing process and simply transferring the documents electronic does not make this a novel invention. In summary there is lots of prior art and more importantly existing business processes that this application reads on.

Response to Arguments

Applicant's arguments filed 3/17/09 have been fully considered but they are not persuasive.

In particular, and respect to Claim 1 the Applicant argued 1st on page 13-14 of the applicants response the applicant simply reiterated the limitations of claim 1 without providing any specific arguments.

Since no specific arguments were address on these pages the examiner is unaware what addition clarification is necessary – each limitation has already been addressed above. The applicant underlined “live coaching” and “modifications of life intensions” for emphasis both of these limitations will be addressed below.

Applicants argued 2nd, prior art did not teach "modifications of life intensions" (page 14-16).

The Examiner refutes the argument made by the Applicant and draws the attention to Wolfberg, Figure 7, item 216 “update client file” this includes the payment as the applicant argued but also the investment files – which contain the goal amount or “life goal” as the applicant describes it. In addition the examiner would like to note that while she choose

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Wolfberg as a solid prior art reference the examiner believe this limitation reads on lots of prior art. One example would be Albright (patent 6,012,043) see claim 19 which states “modify financial (life) goal”. The examiner has not used this above because she believes Wolfberg is a solid reference but to have compact prosecution she felt it necessary to provide additional support. Not only do Wolfberg and Albright contain this limitation but the examiner would like to point out that just about every financial institution provides the services described in this limitation for their "private client" services. In addition any 101 finance book (such as a self help book like Susie Orman) or a college text book would read on this prior art limitation. Individuals would set up "life goal" like retire and would modify the "life goals" when circumstances changed like had a baby and need to have a “life goal” of a college fund.

Applicants argued 3rd, Wolfberg teaches away from any combination adding any system that offers “live coaching” including the system of disclosed in Sullivan.

The Examiner refutes the argument made by the Applicant and draws the attention to KSR. Applicants’ argues that there is not teaching suggestion or motivation to combine references. KSR forecloses Applicant’s argument that a specific teaching is required for a finding of obviousness. KSR, 127 S.Ct. at 1741, 82 USPQ2d at 1396. Claims 31-41 recite combinations which only unite old elements with no change in their respective functions and which yield predictable results. Thus, the claimed subject matter likely would have been obvious under KSR. The examiner would also like to explain that Wolfberg is appropriate to combined with other references.

Applicants argued 4th, that the limitation of claims 9 & 18 (page 16-17) have not been address and then listed the limitation without any specific arguments.

Once again since no specific arguments were address the examiner is unaware what addition clarification is necessary – each of the limitation has been addressed above.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksa

/Kirsten S Apple/

Primary Examiner, Art Unit 3694